

Attorney's Docket No.: 09010-010002

Applicant : Robertson, et al.  
Serial No. : 09/382,242  
Filed : August 22, 1999  
Page : 4

### REMARKS

At the outset, the undersigned attorney thanks the Examiner for her time and assistance in the prosecution of this application.

#### **Status of the Claims**

Claims 21-26 are currently pending. In the present Response, claims 22-24 and 26 are amended; and new claims 27-33 are added. Thus, after entry of these amendments, claims 21-33 are presented for consideration.

#### *Allowed claims*

Applicants thank the Examiner for finding claims 21-25 allowable. Applicants have made only minor amendments to claims 22-24 to accommodate new independent claims 26 and 27 and dependent claims 28-33.

#### *Outstanding rejections*

The rejection of claim 26 under 35 U.S.C. §112, second paragraph, for allegedly being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention is maintained. The rejection of claim 26 under 35 U.S.C. §102(a or b) as allegedly anticipated by Genbank Accession No. X86487 or Kim *et al.* is also maintained.

Applicants respectfully traverse all outstanding objections to the specification and rejections of the claims.

#### **Support for the Claim Amendments**

Applicants respectfully request entry of the amendments set forth in this response under 37 CFR §1.116. The amendment places the case in condition for allowance and places the case in better condition for appeal; the amendment does not raise any issues of new matter; and, the amended and new claims do not present new issues requiring further consideration or search.

Attorney's Docket No.: 09010-010002

Applicant : Robertson, et al.  
Serial No. : 09/382,242  
Filed : August 22, 1999  
Page : 5

For example, support for claim amendments to an oligonucleotide probe wherein the probe has a nucleic acid that consists of a nucleic acid sequence that hybridizes under stringent conditions to the nucleic acid sequence of SEQ ID NO:23 can be found, *inter alia*, at page 13, lines 3-9 and 13-16 of the specification. Support for new claims directed to an oligonucleotide probe wherein the probe has a nucleic acid that consists of a nucleic acid sequence that hybridizes to a nucleic acid sequence having 95% identity to SEQ ID NO:23, and new claims drawn to the various lengths of the probes can be found, *inter alia*, at page 13, lines 13-16 and 19-25. Amended claim 22 and new claims 31-33 drawn to fully complementary oligonucleotide probes, probes of a length in the claimed range, and detectable labels can be found, *inter alia*, in claims 22-25 as originally filed. Thus, Applicants submit that no new matter has been introduced by the present amendment.

#### Issues under 35 U.S.C. §112, first paragraph

The Patent Office alleges that claim 26 is indefinite in the recitation of "medium to reduced stringency conditions" as the specification does not define what conditions constitute 'stringent.'" Applicants have amended claim 26 to recite to stringent hybridization. Parameters for what constitutes stringent conditions are provided in the specification at least at page 10, lines 7-11. Thus, Applicants submit that the application teaches one of skill in the art what conditions would constitute stringent conditions. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection based upon 35 U.S.C. §112, first paragraph, as applied to amended claim 26.

#### Issues under 35 U.S.C. §102

Claim 26 remains rejected under 35 U.S.C. §102(a or b) for allegedly being anticipated by Genbank Accession No. X86487 or Kim *et al.*

On page 3 of the Office Action, the Patent Office alleges that claim 26 encompasses any nucleic acid comprising a sequence which will specifically hybridize to SEQ ID NO:23. Applicants have amended claim 26 to recite a probe wherein the probe comprises a nucleic acid sequence that consists of a sequence that specifically hybridizes to SEQ ID NO:23. Accordingly,

Attorney's Docket No.: 09010-010002

Applicant : Robertson, et al.  
Serial No. : 09/382,242  
Filed : August 22, 1999  
Page : 6

Applicants submit that neither of the references, Genbank Accession No. X86487 or Kim, anticipate amended claim 26. Applicants respectfully request reconsideration and withdrawal of the rejection based upon 35 U.S.C. §102(a or b).

#### CONCLUSION

Claims 21-26 are pending in the application. Claims 22-24 and 26 have been amended; and claims 27-33 have been added by the present Response. Applicants request that the Examiner reconsider the application and claims in light of the foregoing reasons and amendments and respectfully submit that the claims are in condition for allowance.

If, in the Examiner's opinion, a telephonic interview would expedite the favorable prosecution of the present application, the undersigned attorney would welcome the opportunity to discuss any outstanding issues and to work with the Examiner toward placing the application in condition for allowance.

Attached is a marked-up version of the changes being made by the current amendment.

Attorney's Docket No.: 09010-010002

Applicant : Robertson, et al.  
Serial No. : 09/382,242  
Filed : August 22, 1999  
Page : 7

Applicants believe that no fees are necessitated by the present Response. However, in the event any fees are due, the Commissioner is hereby authorized to charge any such fees to Deposit Account No. 06-1050.

Respectfully submitted,

Date: \_\_\_\_\_

*July 26, 2002*

  
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Applicant : Robertson, et al.  
Serial No. : 09/382,242  
Filed : August 22, 1999  
Page : 8

Attorney's Docket No.: 09010-010002

**Version with markings to show changes made**

**In the claims:**

Claims 22-24 and 26 have been amended as follows:

22. (Amended) An oligonucleotide probe fully complementary to an oligonucleotide probe of claims 21, 26, or 27 [Claim 21].

23. (Amended) The oligonucleotide probe of [claims 21 or 22] claim 22, wherein the probe is 20-50 nucleotides in length

24. (Amended) The oligonucleotide probe of claim 22, [claims 21 or 22] wherein the probe is labeled with a detectable label.

26. (Twice Amended) An oligonucleotide probe comprising a nucleic acid sequence consisting of a sequence which specifically hybridizes under [medium to reduced stringency] stringent conditions to a nucleic acid comprising SEQ ID NO:23 or a sequence fully complementary thereto to form a detectable target probe duplex.

Claims 27-33 have been added.

Attorney's Docket No.: 09010-010002

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**FOR THE PERSONAL ATTENTION OF:**

**EXAMINER REBECCA E. PROUTY**

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Number of pages including this page 10

Applicant : Robertson, et al.  
Serial No. : 09/382,242  
Filed : August 22, 1999

Art Unit : 1652  
Examiner : Rebecca E. Prouty

**FACSIMILE COMMUNICATION**

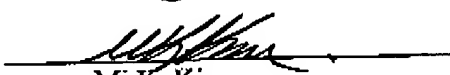
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Washington, D.C. 20231

Attached to this facsimile communication cover sheet is a Response and Amendment and a Transmittal Letter and Petition for Extension of Time faxed this 26<sup>th</sup> day of July, 2002, to Group 1652, of the United States Patent and Trademark Office.

Respectfully submitted,

Date: July 26, 2002

  
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